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| 09/368,828      | 08/05/1999  | ALEXANDER MASHINSKY  | 9118-037            | 5985             |

7590 06/10/2003

Arbinet-theexchange, Inc.  
75 Broad Street  
20th Floor  
New York, NY 10004

EXAMINER

TIEU, BINH KIEN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2643

DATE MAILED: 06/10/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

# Office Action Summary

Application No.

09/368,828

Applicant(s)

MASHINSKY ET AL.

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27, 38-73 and 75-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-27 and 38-64 is/are allowed.
- 6) ☒ Claim(s) 65-73, 75-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 65-<sup>73</sup> are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (U.S. Pat. #: 5,794,207) in view of Taylor et al. (U.S. Pat. #: 5,790,642)(**Both references were cited in the previous Office Action(s).**)

Regarding claim 65, Walker teaches a goods and/or service sale system as shown in figure 1, comprising:

a plurality of sellers (i.e., seller interfaces 300);

a plurality of buyers (i.e., buyer interfaces 400);

a secure network site connected to a server node (i.e., central controller 200) for receiving sell and purchase orders from the sellers and buyers, respectively, for goods and/or services (i.e., conditional purchase offer (CPO) are inputted by buyers and sells are inputted by sellers, col.17, line 48 - col.29; also note that seller database contains sellers' information such as type of services provided by sellers, such information are provided by the sellers when they registered, col.13, lines 10-22);

for each sell order, means for verifying the seller's goods or service parameters (col.19, lines 29-45);

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a database for storing sell and purchase orders (i.e., purchase confirmation database 270 storing sellers' responses, col.19, lines 49-54; database 265 for storing CPOs of buyers, col.17, lines 48-56; or other confirmation databases, col.13, lines 40-49); and

means for identifying a seller's service or goods that automatically satisfied a buyer's service purchase order (i.e., central controller 200 receives a seller response among the plurality of sellers. It should be understood that the central controller 20 identifies a seller providing seller response, based on extracted seller's ID, and automatically binding the seller response to one of the plurality of received CPOs that satisfies a buyer's service purchase order, col.19, lines 30-45).

It should be noticed that Walker teaches the method of trading goods and/or services including Airline tickets, Hotel services, Car Insurance services, etc. as stated above. Walker fails to teach such method of trading in a telecommunications environment. However, it should be noticed that Walker teaches bids and their negotiations are transmitted via any type of communications means such as fax, telephone, Internet, E-mail, etc. It is well-known by those skilled in the art to realize that competitive telecommunications services are provided by different telecommunications service providers with different offering rates that allowed caller to select the best service provider to route his or her call such as taught by Taylor et al. ("Taylor"). Taylor teaches a competitively bidding service centers and a method for trading telecommunications services or for providing a telecommunications sale. Taylor teaches that the center 102 as shown in figure 1 provides services to its subscribers such as fax machines 113a connected to it (col.4, lines 41-49). Taylor further teaches that the center 102 acts as a "service node" or "broker" that receives service requests from the fax machines 113a and formatted into

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bid requests included parameters of telephone number of destination terminal, length of call, time, and other cost factors or required information (col.4, lines 60-67) for a purpose of bidding the lowest cost of a telecommunication service.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of method of bidding for telecommunication services, as taught by Taylor, in place of the bidding for trading goods and services, into view of Walker, in order to provide benefit of telecommunication service users on offered telecommunication services.

Regarding claim 66, Walker further teaches the limitations of the claim in the figure 1, central controller 200.

Regarding claims 67 and 68, Walker further teaches the limitations of the claims in col.23, lines 20-25.

Regarding claims 69 and 70, Walker further teaches the limitations of the claims in col.19, lines 29-37 that the seller is an airline which is not a telecommunications carrier.

Regarding claim 71, Walker further teaches that when the CPO is received from the user as requested, if the available credit on the buyer's credit card is sufficient, the CPO is approved and a unique tracking number is added to the CPO, col.17, lines 27-51; col.28, lines 5-8.

Otherwise, the CPO is rejected and returned to the buyer.

Regarding claims 72-73, Walker further teaches the limitations of the claims in col.16, lines 46-51.

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1. Claims 75-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Pat. #: 5,794,207) in view of Taylor et al. (U.S. Pat. #: 5,790,642) as applied to claim 65 above, and further in view of Coyle (U.S. Pat. #: 6,269,157 also cited in the previous Office Action).

Regarding claims 75-77, Walker and Taylor, in combination, teaches all subject matters as claimed above, except for class of service including levels of quality for each service, etc. assigned by sellers (telecommunications carriers) and requested by buyers. However, Coyle teaches such feature in col.2, line 64 - col.3, line 4; col.7, lines 33-36; col.27, lines 9-20; also see dependent claims 8, 25 and 46 of the Patent.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the telecommunications service request with specified class of service from buyer and offered from sellers, as taught by Coyle, into view of Walker and Taylor, in order to complete calls to geographic regions with satisfied routing service and to avoid telecommunications traffic congestion at the time.

***Allowable Subject Matter***

2. Claims 1-27 and 38-64 are allowed.

***Response to Arguments***

3. Applicant's arguments filed 5/6/2003 have been fully considered but they are not persuasive.

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In response to Applicant's arguments stated from line 16 through line 20, page 2 in his remarks wherein the Applicant stated that as following:

**“...the ‘090 patent does not disclose or suggest a network that receives both purchase and sell orders...and a means for matching the sell and purchase orders...”**

The Examiner respectfully disagrees with the Applicant's arguments as stated above.

Walker '090 teaches a conditional purchase offer (CPO) management system that receives CPOs from buyers wherein the CPOs are read on “**purchase orders**”. The CPOs are forwarded to service providers such as carriers. The CPO management system thereafter awaits acceptance by a service provider such as an interexchange carrier. Thus, the acceptance is clearly read on “**sale order**” issued by the service provider. Therefore, the CPO management system receives both purchase and sell orders. It further noticed that the CPO management system processes, in real time, thousands of CPOs. Consequently, CPO management system should inherently match the thousand(s) of CPOs from buyers with the thousands of acceptances issued by service providers. As discussed several times in telephone interviews with previous Attorney during the prosecutions in the parent case, the Examiner readily pointed out that the claims fails to recite the limitations of “receiving said sale orders, by said server node, before receiving said purchase orders” for a purpose of overcoming the cited prior art. However, the Applicant has failed to do so. Therefore, the teachings of the cited prior art of record read on such features.

In response to the Applicant's arguments stated in the third paragraph, page 2 in his remarks wherein the Applicant stated as following:

**“...the ‘090 patent (filed on September 04, 1997) has a later filing date than that of the parent application of the present application....”**

The Examiner respectfully agrees with the Applicant's correct indication above.

However, It is noted that the Walker '090 is Continuation-in-part of application No. 08/889,319,

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filed on July 08, 1997 having filing date earlier than the filing date of the parent application of the present application. Walker '090 discloses the CPO management system to be applied as the same as one disclosed in the application No. 08/889,319, now having US Patent No. 5,790,642 ("Walker '642"). Walker '090 further teaches the CPO management system is also applied for bidding for services in telecommunications network environment. Therefore, the Examiner believes that the combination of Walker '642 and Taylor et al. in the rejection of the claims above in this Office Action is proper and permissible in the merits.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Binh K. Tieu** whose telephone number is **(703) 305-3963** and E-mail address: **BINH.TIEU@USPTO.GOV.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Curtis Kuntz**, can be reached on **(703) 305-4708** and Customer Service **(703) 306-0377**.

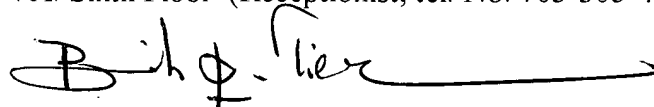
**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

**(703) 872-9314**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, and Arlington, VA. Sixth Floor (Receptionist, tel. No. 703-305-4700).



**BINH TIEU**  
**PRIMARY EXAMINER**

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**Date: June 06, 2003**